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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,567	01/31/2006	Ralf Franzgrote	40149/01101	6155
30636 7590 01/05/2010 FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038				
EXAMINER				
PIERY, MICHAEL T				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/566,567

**Applicant(s)**

FRANZGROTE, RALF

**Examiner**

MICHAEL T. PIERY

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 22, 2009 has been entered.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 26-28, 31, 32, 34, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. (US 5,811,053) in view of Hiraiwa et al. (US 6,673,296).

Regarding claim 26, Ota teaches a method comprising introducing a decor inlay into a space between upper and lower tools of a casting tool (Figure 8), where an edge of the inlay

projects into a cavity between the upper and lower tools (Figure 8b) and filling the cavity with a curing material including polyurethane (Column 3, lines 34-35) enclosing the edging (Figure 8; Column 7, lines 4-7). Ota does not explicitly teach clamping the inlay, however, clamping is well-known in the art and would have been obvious to one of ordinary skill in the art at the time of the invention in order to prevent the inlay from moving during the injection process. Ota does not explicitly teach a remaining portion of the décor is outside the cavity, the cavity being sealed. However, Hiraiwa teaches it is known to form a décor inlay by molding with a portion of the inlay outside the cavity (Figure 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the process of Ota to keep a portion of the inlay outside of the cavity because it is aesthetically desirable for inlays to have portions that are just trim and do not have molded resin attached.

Regarding claim 27, Ota teaches the trim part is for a motor vehicle (Column 1, lines 9-11).

Regarding claim 28, Ota teaches the skin has a thickness of 1.5 mm (Column 7, lines 45-48).

Regarding claim 31, Ota teaches using a web (Figure 8b, #76) and corresponding recess (62) to clamp and mold the inlay. The web is on the upper tool, however, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the web on the lower tool since it has been held that rearrangement of parts is within routine skill of one in the art.

Regarding claim 32, Ota teaches the web has a height of 5-10 mm (Column 5, lines 15-17).

Regarding claim 34, Ota teaches holding the inlay using a vacuum (Column 6, lines 40-47).

Regarding claim 36, Ota teaches the décor inlay is encased peripherally by the cast skin (Figure 10).

Regarding claim 37, Ota teaches the inlay is leather (Column 3, lines 32-33).

Regarding claims 38 and 39, the examiner takes official notice it is well-known to coat the back of leather and textiles with foam-tight material in order to prevent degradation of the foam layer and undesirable penetration of the foam into the textile or leather material.

3. Claims 30, 33, 35 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. in view of Hiraiwa et al., as applied to claims 26 and 31 above, and further in view of Spengler (US 6,214,157).

The modified Ota reference teaches the method of claims 26 and 31, as applied above.

Regarding claims 30 and 33, Ota does not explicitly teach divided regions of the tool. However, Spengler teaches the upper and lower tools are divided such that the regions are liftable and lowerable (Figure 2). Ota teaches grooves of trim components become stretched and aesthetically displeasing during typical press molding operations (Column 2, lines 1-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the process of Ota to include the movable mold of Spengler because the mold of Spengler prevents the undesirable appearance of the groove (Column 2, lines 1-19).

Regarding claim 35, Spengler teaches providing a positioning pin (Figure 2 #7). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate

multiple positioning pins since it has been held that duplication of parts is within routine skill of one in the art.

Regarding claim 40, Spengler teaches pushing together the joint to minimize the gap (Column 6, lines 19-33).

4. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ota et al. in view of Hiraiwa et al. as applied to claim 26 above, and further in view of Loren (US 4,847,024).

The modified Ota reference teaches the method of claim 26, as applied above.

Regarding claim 29, Loren teaches it is known to coat mold surfaces with paint before molding an article. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Ota to include the mold coating steps of Loren because painting the surface of the trim component provides an aesthetically pleasing appearance.

#### ***Response to Arguments***

Applicant's arguments filed August 20, 2009 have been fully considered but they are not persuasive.

Applicant argues that the resin in Ota does not enclose the edging of the surface skin member but merely abuts it on one side. Claim 26, however, does not require the resin to enclose the skin member. Rather, claim 26 requires the skin member to be enclosed, but not specifically enclosed by the resin. Ota teaches the skin member is enclosed by the resin and the lower tool.

Applicant argues that Hiraiwa does not teach the remaining portion of the inlay being accommodated outside the cavity while also being disposed in a space between upper and lower tools of a casting tool. Hiraiwa teaches a portion of the inlay outside the cavity where the resin is filled (figure 4, 11a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL T. PIERY whose telephone number is (571)270-5047. The examiner can normally be reached on M-Th 8:30-7.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael T Piery/  
Examiner, Art Unit 1791

/Monica A Huson/  
Primary Examiner, Art Unit 1791